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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/768,867 | 01/24/2001 | Vittorio Castelli | XXT-055A (D/99368) | 3156 |

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28 STATE STREET
BOSTON, MA 02109

EXAMINER

COLILLA, DANIEL JAMES

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2854

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DATE MAILED: 03/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/768,867

Applicant(s)

CASTELLI ET AL.

Examiner

Dan Colilla

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-8 and 13-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-8 and 13-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 2854

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In claim 15, applicant states that the printing device includes a printing area located over the paper guide/biasing member position. It appears then, from applicant's Figure 1, that the biasing member would be between the printing device and paper guide. It is not clear how the printing device can create an image on the paper if the biasing member is located in this manner.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 14, 18 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki.

With respect to claims 1, 18 and 21, Suzuki discloses an apparatus including a paper guide 3, a biasing member 21 biased against the paper guide 3 in which the edge of a printing

Art Unit: 2854

device 2 extends beyond the paper guide to a position upstream of the paper guide 3 (see Figure 1 of Suzuki).

With respect to claim 2, the paper guide 3 is a rotatably mounted cylinder and is perpendicular to the paper travel path.

With respect to claim 3, the biasing member 21 is a leaf spring.

With respect to claim 14, Suzuki discloses a printing device 2 positioned such that it is located over a position where the biasing member 21 and paper guide 3 meet as shown in Figure 1 of Suzuki.

5. Claims 1, 3-4 and 14-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Van Horne et al.

With respect to claim 1, In the embodiment shown in Figures 7A-7G, Van Horne et al. discloses a paper guide 132, a biasing member 138 biased against the paper guide 132, and a printhead extending past the guide member 132 in an upstream direction.

With respect to claim 3, Van Horne et al. discloses that the biasing member 138 can be considered a pinch spring.

With respect to claim 4, Van Horne et al. discloses a biasing member 138 with two ends, one of which is attached to the printer. Figures 7A-7C of Van Horne et al. show that the biasing member 138 is substantially aligned with the paper path.

With respect to claim 14, Van Horne et al. discloses a position where the paper guide 132 and biasing member 138 meet as shown in Figure 7C of Van Horne et al.

To the extent that claim 15 is understood, Van Horne et al. discloses printhead 156 positioned over the point where paper guide 132 and biasing member 138 meet as shown in Figure 7C.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 13, 17, 19-20, and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki in view of Smolenski.

With respect to claims 13, 19 and 22, Suzuki discloses the claimed method except for moving a printing device. Suzuki discloses a method including the steps of biasing a biasing member 21 against a paper guide 3 in which the edge of a printing device 2 extends beyond the paper guide to a position upstream of the paper guide 3 (see Figure 1 of Suzuki). Smolenski teaches a method of using a thermal printer for forming an image using a printhead 6. Figures 4-5 of Smolenski show that the printhead can be moved over the piece of paper. It would have been obvious to combine the teaching of Smolenski with the method disclosed by Suzuki for the advantage of the floating print head which is correctly positioned for printing when the lid 3 of the printer is closed.

Art Unit: 2854

With respect to claim 16, Suzuki discloses a printing device 2 positioned such that it is located over a position where the biasing member 21 and paper guide 3 meet as shown in Figure 1 of Suzuki.

With respect to claims 17, 20 and 23, Suzuki discloses the structure of the apparatus as mentioned above in the prior art rejection of claim 1 and further discloses a printing device 2 positioned such that it is located over a position where the biasing member 21 and paper guide 3 meet as shown in Figure 1 of Suzuki.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Osada et al. is cited to show another example of a printer with a paper guide and a biasing member.

Response to Arguments

9. Applicant's arguments with respect to claims 1-4 and 6-23 have been considered but are moot in view of the new ground(s) of rejection.

The examiner would like to apologize for the incompleteness of the previous Office action. It appears that claims 14-16 had not been addressed at all. Therefore, this Office action has been made non-final.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Colilla whose telephone number is (703) 308-2259. The examiner can normally be reached M-F, 8:30-5:30. Faxes regarding this application can be sent to (703) 746-4405.


Application/Control Number: 09/768,867

Page 6

Art Unit: 2854

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached at (703)305-6619. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

March 3, 2003


Dan Colilla
Primary Examiner
Art Unit 2854